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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,188	12/02/1999	SHOICHI YAMAGUCHI	862.3158	9981

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NEW YORK, NY 10112

EXAMINER

WON, YOUNG N

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 06/11/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/452,188

Applicant(s)

YAMAGUCHI, SHOICHI

Examiner

Young N Won

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-14-03.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

1. Claims 3-5, 7-9, 12, 13, and 15-17, and amended claims 1, 2, 6, 10, 11, 14, and 18, have been examined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Independent:

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US Pat No.5608786).

As per claims 1 and 10, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") and a method (see col.1 lines 5-13) connected to a communication network (see Fig.1, #4 & #10), said apparatus and method comprising: destination designating means for designating a destination apparatus (see col.2, lines 25-28 & 44-54); facsimile communication means for transmitting the transmission information inputted by said input means to a destination apparatus in accordance with

facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); encryption means for encrypting the transmission information inputted by said input means (see col.9, lines 18-33) without using the communication network (It is inherent that when data is encrypted, it is done either on the sending device or the receiving device and does not involve the communication network); electronic-mail communication means for transmitting the transmission information inputted by said input means or encrypted by said encryption means to a destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); communication designating means for causing transmission of the transmission information by selecting either said facsimile communication means or said electronic-mail communication means (see col.2, lines 44-54 and col.3 lines 36-38); security designating means for designating whether the transmission information is confidential information (see col.9, lines 28-33); and control means for controlling said facsimile communication means, said encryption means, and said electronic-mail means such that (see col.9, lines 19-26: it is inherent that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system) if the transmission information has been designated as being confidential information by said security designating means, said facsimile communication means transmits the transmission information to the destination apparatus by facsimile transmission (see col.2, lines 50-54 and col.9 lines 23-26) through the communication network, when said facsimile communication means has been designated by said communication designating means (see col.3, lines 30-35), and said electronic-mail communication means sends the

encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication means has been designated by said communication designating means (see col.2 lines 31-35 and col.2, lines 30-35). Gordon does not explicitly teaches of an input means for inputting transmission information to be transmitted to the destination apparatus designated by said destination designating means without using the communication network, but it is inherent that all devices uses for the purpose of transferring information such as a fax, laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, and software to input telephone numbers or email addresses.

As per claim 18, Gordon teaches of a communication apparatus (see col.1 line 66: "messaging system") connected to a communication network (see Fig.1, #4 & #10), said apparatus comprising: a destination designating unit adapted to designate a destination apparatus (see col.2, lines 25-28 & 44-54); a facsimile communication unit adapted to transmit the transmission information inputted by said input unit to a destination apparatus in accordance with facsimile communication specifications (see Fig.1 # 10 & #14 and col.3 lines 41-44); an encryption unit adapted to encrypt the transmission information inputted by said input unit (see col.9, lines 18-33) without using the communication network (It is inherent that when data is encrypted, it is done either on the sending device or the receiving device and does not involve the communication network); an electronic-mail communication unit adapted to transmit the transmission information inputted by said input unit or encrypted by said encryption unit to a

destination apparatus in accordance with electronic-mail specifications (see col.2 lines 4-6); a communication designating unit adapted to cause transmission of the transmission information by selecting either said facsimile communication unit or said electronic-mail communication unit (see col.2, lines 44-54 and col.3 lines 36-38); a security designating unit adapted to designate whether the transmission information is confidential information (see col.9, lines 28-33); and control unit adapted to control said facsimile communication unit, said encryption unit, and said electronic-mail communication unit (see col.9, lines 19-26: it is inherent that when Gordon says "transparently to the sender and the receiver", there is a means of control by the "state of the art" system) such that, if the transmission information has been designated as being confidential information by said security designating unit, said facsimile communicating unit transmits the transmission information to the destination apparatus by facsimile transmission through the communication network, when said facsimile communication unit has been designated by said communication designating unit (see col.3, lines 30-35), and said electronic-mail communication unit sends the encrypted transmission information to the destination apparatus by electronic mail through the communication network, when said electronic-mail communication unit has been designated by said communication designating unit(see col.2 lines 31-35 and col.2, lines 30-35). Gordon does not explicitly teaches of an input unit adapted to input transmission information to be transmitted to the destination apparatus designated by said destination designating unit without using the communication network, but it is inherent that all devices uses for the purpose of transferring information such as a fax,

laptop, telephone, personal computer, and scanner (see Fig.1), all have an input means such as number pad, keyboard, mouse, and software to input telephone numbers or type email addresses.

Dependent:

As per claims 2-3 and 11-12, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 1 and 10, and a computer-readable recording medium storing a computer program for implementing functions described in claims 1 and 10 (see col.6 lines 18-20).

As per claims 4, 5, and 13, Gordon further teaches wherein, if the destination apparatus possesses a private security function, said facsimile communication means checks to determine whether the destination apparatus possesses a private security function by inquiring as to whether the destination apparatus possesses the private security function when a communication path to the destination apparatus is formed and transmits the transmission information by confidential communication utilizing the private security function, when the transmission information has been designated as being confidential information by said security designating means (see col.9 lines 18-28).

As per claims 6, 7, 14, and 15, Gordon further teaches of a computer program product embodying a computer program for implementing functions described in claims 5 and 13 and a computer-readable recording medium storing a computer program for

implementing functions described in claims 5 and 13 (see col.6 lines 18-20 and col.10 lines 21-23).

As per claims 8, Gordon further teaches wherein said security designating means makes a determination that the transmission information is confidential information when transmission by confidential communication is designated (see col.6 lines 28-33).

As per claims 9 and 16, Gordon further teaches wherein said input means comprises a document reader and the transmission information, is inputted by reading a document using the document reader (see col.1 lines 5-10).

3. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US Pat No.5608786) in view of Yamada (US Pat No.5521719). Gordon teaches all the limitations of claim 17 including wherein the communication network includes at least a telephone network, but he does not teach that the communication network includes a LAN. Yamada teaches wherein the communication network includes at least a telephone network and a LAN (see Fig.9, #117 & #123 and col.4, lines 43-48). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ the teachings of Yamada within the system of Gordon by implementing a LAN network and a PSTN network within the communication apparatus and method because, Gordon teaches us that other networks may be employed (see col.10, lines 6-9), thus it would be obvious to employ Local Area Network if there was a demand for such a network for this system.

Response to Arguments

4. Applicant's arguments filed April 15, 2003 have been fully considered but they are not persuasive. Gordon and by reasons of inherency clearly teach and meet the limitations presented in the amendment (see claim 1, 10, and 18 rejections above.

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "According to Claim 1, ... confidentiality of the transmission information is maintained." as recited in the remarks on page 11, second paragraph of the amendment) are not recited in the rejected claim(s). The claim limitation simply states "encrypting the transmission information... without using the communication network". There is no suggestion in the claims as to state "encrypting the transmission information before transmission through the communication network" as suggested by the remarks. The examiner believes that the encryption scheme is not the novel feature of the applicants claimed invention, and new art could be applied in overcoming the differences argued in the remarks of the amendment with respect to encryption.

6. All dependent claims remain rejected.

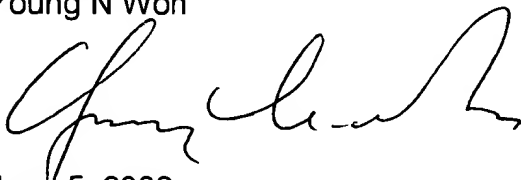
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



June 5, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100